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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,031	01/08/2001	William Chadwick	INF 2005	3569

7590

05/09/2002

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EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 05/09/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-3

Office Action Summary	Application No.		Applicant(s)	
	09/755,031		CHADWICK, WILLIAM	
	Examiner		Art Unit	
	Dionne A. Walls		1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to an orally administered composition for reducing tobacco consumption, classified in class 131, subclass 270.
 - II. Claims 11-17, drawn to a method of reducing tobacco consumption in a human, classified in class 131, subclass 270.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product, such as a composition having no base ingredient, and having only *Plantago major* and an additive for diminishing the odor characteristics.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Terry Kramer on Wednesday, May 1st a provisional election was made with traverse to prosecute the invention of Group I, an orally administered composition for reducing tobacco consumption, claims 1-10.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 11-17 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-6, and 10 are rejected under 35 U.S.C. 102(b) as being by anticipated by DE 3140831.

DE 3140831 discloses all that is recited in the claims (Note: “sugar/powder” corresponds to the claimed “base ingredient”; “peppermint/mint/cloves” corresponds to the claimed “additive for diminishing the odor characteristics of tobacco”/ “masking agent”; “menthol” corresponds to the claimed “additive for diminishing the odor characteristics of tobacco”/ “antiseptic agent”; “powder” corresponds to the claimed “base ingredient...solid form”; see attached abstract).

7. Claims 1, and 7-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Cody (US. Pat. No. 6,063,401).

Cody discloses all that is recited in the claims (Note: “liquid carriers/liquid core solvents” correspond to the claimed “base ingredient/liquid form”; “citric acid” corresponds to the claimed “additive for diminishing the odor characteristics of tobacco”/ “neutralizing agent”; col.2, lines 38-40; cols. 5 and 6).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2, 7-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitson-Fischman (US. Pat. No. 5,162,037) in view of Cody (US. Pat. No. 5,716,635).

Whitman-Fischman discloses a composition for the treatment of chemical dependencies in the form of a lollipop (corresponding to the claimed "base ingredient"/"solid form"), upon which a homeopathic mixture of an herb and extract of citrus seed (corresponding to the claimed "additive for diminishing the odor characteristics of tobacco"/ "neutralizing agent"/ "citrus extract") is applied (col. 1, lines 15-21 and 47-49; col.2, lines 36-34; col. 7, lines 33-44; col. 8, lines 52-54; see examples 1 and 24; see fig. 1). While Whitman-Fischman may not disclose that the homeopathic herbal mixture comprises *Plantago major* as its herb, Cody discloses in its "Background of the Invention" section that the herb *Plantago major* has been known as a tobacco deterrent for many years (col. 2, lines 63-65), and that oral administration of *Plantago major* caused an aversion to tobacco in humans. Also, it is stated that various dilutions in ethanol and water of the herb has also been used orally (col. 3, lines 1-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include *Plantago major* as an herb in the homeopathic mixture of

Art Unit: 1731

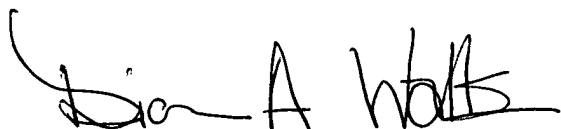
Whitman-Fischman because, as taught in Cody, such herb, in dilute forms, is known for its benefits in encouraging a smoker's withdrawal from nicotine which is consistent with the goal of the composition in Whitson-Fischman – treating addictive dependencies using herbal mixtures.

Conclusion

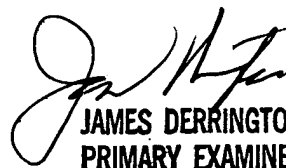
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Dionne A. Walls
May 4, 2002



JAMES DERRINGTON
PRIMARY EXAMINER
ART UNIT ~~137~~-1731